



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,739	08/16/2006	Keiji Sakai	66091(70904)	9507
21874	7590	08/13/2008		
EDWARDS ANGELL PALMER & DODGE LLP			EXAMINER	
P.O. BOX 55874			PSITOS, ARISTOTELIS M	
BOSTON, MA 02205				
		ART UNIT	PAPER NUMBER	
		2627		
		MAIL DATE	DELIVERY MODE	
		08/13/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/589,739

**Applicant(s)**

SAKAI ET AL.

**Examiner**

Aristotelis M. Psitos

**Art Unit**

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 2627

### **DETAILED ACTION**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

The submitted IDS documents have been reviewed and made of record.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4,5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-6 attempt to broaden the base/parent claim. The parent claim is drawn to a single element, While claims 4 and 5 attempt to include additional elements – they do not further limit the claimed previous element. These claims are best re-written in independent form.

With respect to claim 5 it recites a third photodetector; however, as since this is the only photodetector in the chain of claims this is not understood. The examiner believes this claim should depend from claim 4.

Claim 6 depends from claim 5 and falls accordingly.

As far as the claims recite positive limitations and are interpreted, the following art rejections are made.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2627

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1 Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2003-272207.

Applicants' attention is drawn to paragraphs 11-42 in the accompanying MAT (machine assisted translation) of the JP document which discloses the claimed elements.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

Art Unit: 2627

examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2 Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraph 1 above, and further in view of JP 2003-272207/Official notice.

Claim 4 recites two photodetectors, as disclosed in paragraph 17 of the MAT of the above JP document; there are two portions of a photodetector array that performs the functions.

The ability of having separate detectors, as opposed to two portions of a photodetector/array is considered merely an engineering feat, i.e., providing for plural separate elements as opposed to an integrated element with different sections/portions. Official notice is taken of such engineering feats.

It would have been obvious to modify the base system as relied upon above with such well known techniques motivation is to ensure proper signal separation.

3 Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraph 1 above, and further in view of JP 2000-076689.

The integrated package assembly of these claims is well known and taught by the JP document 2000-076689.

It would have been obvious to modify the base system as relied upon above with this additional capability, motivation is to provide for an integrated package for optical systems capable of both CD and DVD playback.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al.

The examiner is providing US patent 6574182 as the English translation of the PCT WO 00/36597 equivalent.

The WO document (as described in the equivalent US patent) discloses an optical pick up system and as further detailed in figures 17+, provides for an appropriate angle of divergence for the laser

Art Unit: 2627

beams. This meets the claimed limitations with respect to the radiation angle separation. The RIM value is met by the various ranges of RIM described in association with the above noted figures.

The detector arrangement –see the description of figures 1, 7, 10, etc.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraph 4 above, and further in view of Yamada et al – 7099085. The appropriate photodetector and integrated package is described with respect to figures 7 plus.

It would have been obvious to modify the base system as relied upon above in paragraph 4 with such alternative package capability in order to yield an integrated unit for both cd and DVD capabilities.

6. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Aiki et al.

Aiki et al discloses in an optical system – see figures 1-7 for instance, the ability of providing appropriate angular separation with respect to the different laser sources – see the disclosure starting at col. 5 line 14 and continuing till col. 8 line 11. These lines also describe the RIM requirements.

As far as the examiner interprets the claims, the system so described meets the above claimed limitations.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-4 as stated in paragraph 6 above, and further in view of JP 2000-076689.

The integrated package assembly of these claims is well known and taught by the JP document 2000-076689.

It would have been obvious to modify the base system as relied upon above with this additional capability, motivation is to provide for an integrated package for optical systems capable of both CD and DVD playback.

Art Unit: 2627

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thr: 6:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner  
Art Unit 2627

/Aristotelis M Psitos/  
Primary Examiner, Art Unit 2627